

PATENT
674523-2006.1**REMARKS**

In response to the Office Action dated July 2, 2003, please consider the following remarks. Reconsideration and withdrawal of the restriction requirement are respectfully requested.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 9-12, 15-18 and 20-24 are pending in this application. Claims 9-12, 16-18 and 20-24 have been amended. These amendments are made for clarification and to bring the claim language into better form for U.S. practice. Support is found throughout the specification and from the claims as filed. No new matter is added by this amendment.

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments of and additions to the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §101, §102, §103 or §112 and are not narrowing amendments. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. RESTRICTION REQUIREMENT

The Office Action required restriction from among:

Group I: Claim 23, drawn to a delivery system comprising a non-retroviral expression vector, an adenovirus and/or plasmid, classified in class 435, subclasses 320.1, 325, 455, and class 424, subclass 93.21;

Group II: Claims 9-12, 16-22 (claims dependent therefrom), 23-29 drawn to a retroviral vectors derived from a non-primate lentivirus genome comprising the leader sequences between the end of the 5'LTR and the ATG of *gag*, wherein the genome lacks the *tat* gene, classified in class 435 subclass 320.1; and

Group III: Claim 15, and claims dependent therefrom (16-22), drawn to a hybrid vector system comprising a poxvirus and a retrovirus, classified in class 435, subclass 320.1.

Group II is elected, with traverse, for further prosecution in this application. Applicants reserve the right to file divisional applications to non-elected subject matter. Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herewith.

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As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions." *Id.*

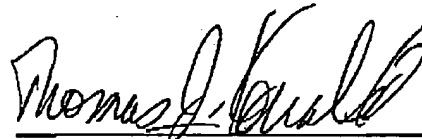
It is respectfully submitted that any search for the retroviral vectors and related methods and systems of the group II claims will certainly encompass references for the subject matter of the groups I and III claims. Indeed, all three groups are classified in class 435, subclass 320.1, and groups II and III are only classified in class 435, subclass 320.1. Therefore, it is respectfully submitted that it would impose no undue burden on the Examiner to search and examine the claims of all of groups I-III, or at the very least, groups II and III, in a single application.

The result of the present restriction requirement is inefficiency and unnecessary expenditures by both the Applicants and the PTO and extreme prejudice to Applicants (particularly in view of GATT, a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since the requisite showing of serious burden has not been made in the Office Action and there are relationships between claim 23 of group I, claims 9-12, 16-22 and 23-29 of group II and claim 15 of group III. These factors mitigate against restriction.

Reconsideration and withdrawal of the requirement for restriction, or at least reformulation of the requirement such that claim 15 is included in group II, and favorable consideration of the claims on the merits are requested.

Respectfully submitted,

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